

## **REMARKS**

### **Summary of the Office Action**

#### **In the Specification:**

1. The disclosure is objected to because of an informality regarding the use of the term "opaque" on page 7, line 21.

#### **In the Claims:**

1. Claims 12, 15, 17, 19-22, 24-28 stand rejected under 35 U.S.C. Section 112, first paragraph, for failing to comply with the written description requirement.

2. Claims 29-34 stand rejected under 35 U.S.C. Section 103(a), as being unpatentable over U.S. Patent No. 6,556,222 ("Narayanaswami") in view of U.S. Patent No. 5,050,139 ("Oberst").

3. Claims 35-39 stand rejected under 35 U.S.C. Section 103(a) as being unpatentable over U.S. Patent Application Publication US20030117380A1 to Kanzaki in view of Narayanaswami.

4. Claim 40 stands rejected under 35 U.S.C. Section 103(a) as being unpatentable over Kanzaki in view of Narayanaswami and further in view of U.S. Patent No. 6,468,212 to Scott.

5. Claim 41-45 stand rejected under 35 U.S.C. Section 103(a) as being unpatentable over Narayanaswami in view of U.S. Patent Application Publication US20030115384A1 ("Sonehara").

### **Summary of the Response**

Claims 17, 29-34 and 40 are cancelled with this paper.

Claims 12, 24, 35 and 41 are currently amended.

Claims 46-48 are new.

Now pending are claims 12, 15, 19-22, 24-28, 35-39, and 41-49.

**Detailed Remarks**

Applicant requests consideration of the following remarks.

A. Claims 12, 15, 17, 19-22, 24-28 stand rejected under 35 U.S.C. Section 112, first paragraph, for failing to comply with the written description requirement.

Applicant respectfully requests reconsideration of this rejection for the following reasons. First, there is an amendment that makes the rejection moot. As provided with the description of FIGS. 3 and 4, the bezel feature is provided with a lid that can cover the display of the electronic device. Thus, there is no “hinge type device” that couples the bezel feature to the housing, as there is now a lid and this forms part of the bezel feature.

Second, Applicant objects to the basis of the rejection as being under lack of written description. The Office Action states that the disclosure lacks “a description of the *hinge type device* that allows the bezel to rotate and still be able to open or close in relation to the display.” It is Applicant’s position that the Office Action is inserting a “hinge type device” into the claim, then formulating a basis for the rejection because such a limitation is not adequately disclosed in the specification. Applicant disagrees with this analysis.

Applicant notes the pertinent portion of the specification provides the written specification and teaching for amended Claim 1:

“The bezel feature includes a lid 225 rotatably mounted over display 220. The lid 225 may be rotatable when in a closed position over display 220...The lid may be moved into an extended position in order to enable a user to enter input by making contact with the display. The lid may be closed in order to operate the lid as a bezel.”  
[Specification, pages 7-8].

What the Office Action is making, in substance, is an enablement rejection, in that “a hinge type device” is being presented as an essential element that must be recited in the claim. This is the premise for the conclusion that the specification does not have written disclosure on the “hinge type device”. But such an enablement rejection is

unfounded. The portion of the Specification recited would enable one skilled in the mechanical arts to recreate the claimed invention.

B. Claims 29-34 stand rejected under 35 U.S.C. Section 112, first paragraph, as failing to comply with the written description requirement.

This rejection is now moot, as Claims 29-34 have been cancelled.

C. Claims 35-39 stand rejected under 35 U.S.C. Section 103(a) as being unpatentable over U.S. Patent Application Publication US20030117380A1 to Kanzaki in view of Narayanaswami.

Kanzaki combined with Narayanaswami does not teach the claimed invention. Claim 35 now recites “detect a continuous contact with the display assembly resulting in a reference point of the bezel feature being moved from a starting point to a finishing point...” where movement of the reference point as the input results in a processor performing an operation. This limitation is not taught or suggested by the cited references.

In making a rejection to Claim 40, the Office Action combines Kanzaki, Narayanaswami and Scott. It is also Applicant’s position that there is no motivation to combine the references as cited. While Applicant believes that no motivation exists to combine any of the references (see arguments made below), the lack of motivation is more fundamental when there are three references being combined.

D. Claim 41-45 stand rejected under 35 U.S.C. Section 103(a) as being unpatentable over Narayanaswami in view of U.S. Patent Application Publication US20030115384A1 (“Sonehara”).

Applicant does not believe the cited references teach the claimed invention, particularly to the point of the bezel feature being formed on a contact-sensitive surface, r the manner in which the bezel can be used to determine input. To distinguish the invention further, Applicant has amended the claim to recite that the bezel feature is formed by a contact-sensitive material that provides a surface on which a pointer may be

dragged to indicate an input". Support for this limitation may be found on, for example, page 14 of the Specification.

E. Lack of Motivation to Combine

With respect to all claims, Applicant requests reconsideration of the motivation used to combine the cited references. Importantly, the lack of motivation means that the Office Action failed to provide a *prima facie* case for making the obviousness rejections. There is no suggestion to combine any of the cited references in a manner that references to teach all elements of the claimed invention. Applicant believes the Federal Circuit has provided a directive that a suggestion to combine references must be "clear and particular". To quote the Federal Circuit in *In re Dembiczak*:

Our case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references. Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability--the essence of hindsight.

Applicant believes many of the rejections made in the Office Action are made with hindsight, and that no adequate suggestion exists to combine the references cited in a manner required by the case law.

Conclusion

For all of the reasons stated above, Applicant believes the application is in condition for allowance. A Notice of Allowance is respectfully requested.

### CONCLUSION

A Notice of Allowance is respectfully requested. If there are any questions or comments that the Examiner wishes to direct to Applicant's attorney, the Examiner is invited to call Applicant's attorney at (408) 551-6632. The Patent Office is authorized to charge all unpaid fees to the deposit account 50-1914.

Submitted by,



Van Mahamedi

Reg. No. 42,828

Correspondence Address:

Van Mahamedi

SHEMWELL GREGORY & COURTNEY

4880 Stevens Creek Boulevard, Suite 201

San Jose, CA 95129

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Print Name: Van Mahamedi